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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/001,364  | 10/25/2001  | Clive P. Hohberger   | 7887/83889          | 3268             |
| 7590  | 04/02/2004  |                      | EXAMINER            |                  |
| Jeffrey W. Salmon<br>Welsh & Katz, Ltd.<br>22nd Floor<br>120 South Riverside Plaza<br>Chicago, IL 60606 |             |                      | DO, AN H            |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2853                |                  |
| DATE MAILED: 04/02/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/001,364             | HOHBERGER ET AL.    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | An H. Do               | 2853                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 23 January 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 173-193 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 173-193 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/19/03 & 6/26/03.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

The Amendment filed on 23 January 2004 has been acknowledged.

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on 19 May 2003 and 26 June 2003 were filed are being considered by the examiner.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 173-193 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petteruti et al (US 6,409,401) in view of Duschek (US 6,334,921).

Petteruti et al discloses in Figures 1-3 a media processing system (10) having an on-demand printing device (18) configured to receive a series of labels, tickets, tags, cards or other media samples (column 3, lines 8-11), the print device (18) responding to print instructions (Figure 2, element 34) custom-configured for selected first and second media samples, which direct the print device (18) regarding whether to print and what to print on the selected first and second media samples (column 3, lines 27-52); a web conveyance (20) to carry media samples (16a) from a supply (14); wherein at least two value-adding elements (16a) are applied to at least one of the first and second media samples (such as labels); two of the value-adding elements have different attributes (column 3, lines 30-34); the value-adding element (16a) comprises RFID circuitry

(column 3, lines 21-24) making contact with an antenna (23), and comprises an RFID transponder (22); the first and second media samples (16a) are adjacent (Figure 1B) in the series of media samples; means for communicating with the transponder (22) by reading/writing information stored in the transponder (column 4, lines 14-20); and configured to print failure India on media sample having an RFID transponder determined to be defective or inaccurately encoded (Figure 3, column 4, lines 33-67 and column 5, lines 1-25).

Petteruti et al discloses the claimed invention except for reciting an on-demand converting system configured to receive the series of media samples and a series of value-adding elements, the converting system responding to application instructions custom-configured for the selected first and second media samples, which direct the converting system to apply or not apply a value-adding element from the series of elements to each of the selected first and second media samples; media separator and a dispenser responsive to custom-configured instructions and couple to a value-adding device.

However, Duschek teaches in Figure 1 an on-demand converting system (1) configured to receive the series of media samples (2) and a series of value-adding elements (8), the converting system (1) responding to application instructions custom-configured for the selected first and second media samples (2), which direct the converting system (1) to apply or not apply a value-adding element (8) from the series of elements to each of the selected first and second media samples (2); media

separator (3, 4) and a dispenser (6) responsive to custom-configured instructions and couple to a value-adding device (8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a converting system to apply the value-adding elements or not, a media separator and a dispenser, as taught by Duschek, for the purpose of removing the labels from a carrier web and placing them in a predetermined position on the carrier web, and then applying security elements to the carrier web as noted in column 1, lines 6-15 of Duschek.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Heredia et al (US 6,327,972) discloses a printer for printing a data carrier with at least one transponder chip. Kathmann et al (US 6,123,796) discloses a method of making and applying combination article security target and printed labels. Chamberlain et al (US 5,660,663) discloses a substrate having adhesive labels for tags, and a dispensing head is provided to dispense security elements onto the substrate. Dowling (US 5,167,752) discloses a labeling apparatus including a supply of a laminated webs passing through a die cutter for cutting labels.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Response to Arguments***

6. Applicant's arguments with respect to claims 173-193 have been considered but are moot in view of the new ground(s) of rejection.

***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to An H. Do whose telephone number is 571-272-2143. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on 571-272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2853

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



An H. Do  
March 23, 2004



Stephen D. Meier  
Primary Examiner